

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

William Chrisman

Serial No.: 09/832,141

Filed: April 9, 2001

For: SCENTED BOWLING BALLS AND
METHODS

Confirmation No.: 8520

Examiner: W. Pierce

Group Art Unit: 3711

Attorney Docket No.: 1858-4826US

**VIA ELECTRONIC FILING
November 13, 2007**

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sirs:

This Reply Brief follows the Examiner's Answer of September 12, 2007, and is being submitted in the format required by 37 C.F.R. § 41.41.

(7) ARGUMENT

(B) REJECTIONS UNDER 35 U.S.C. § 103(a)

(2) REFERENCES RELIED UPON

Shinbanai

It is noted that polyurethane is identified by Shinbanai as a “synthetic resin coating” that may be used to coat the cyclodextrin-fragrance compound of Shinbanai. Col. 7, lines 54-58. Shinbanai teaches that it is necessary to incorporate fragrance into cyclodextrin to prevent evaporation or denaturization of the fragrance during relatively high temperature molding processes. Col. 1, lines 35-42. Shinbanai also teaches that it is necessary to coat the cyclodextrin-fragrance compound with a glycitol to prevent denaturization and charring of reducing sugars when the cyclodextrin-fragrance compound is subjected to high temperatures, such as those used during some molding processes. Col. 2, lines 56-68; col. 3, lines 29-31.

Coffey

The disclosure of Coffey relates to compounds that include dried, ground, fragrant plant matter, such as dried flower petals as a primary component (80% to 98%, by weight) (col. 3, lines 54-55) and a resin binder, such as TEFLON® 30 suspension (polytetrafluoroethylene), as a secondary component (1% to 10%, by weight) (col. 4, lines 39-44).

(3) ANALYSIS

Contrary to the Examiner’s assertions, there have been no attempts during prosecution of the ‘141 Application to define the phrase “two-part resin” in a way that contradicts or is

inconsistent with the plain meaning of that phrase. Nor has there ever been any attempt to mislead the Examiner in any other way during the course of prosecution of the '141 Application.

One of the primary assertions that has been made in the Examiner's Answer is that a bowler is one of ordinary skill in the art of manufacturing bowling balls. Examiner's Answer, page 6. It is respectfully submitted that, since most bowlers do not manufacture their own bowling balls, one of ordinary skill in the art of bowling ball manufacture would be a bowling ball manufacturer, not a bowler.

Regardless, for the reasons that were set forth in the Appeal Brief, the Examiner has not established a *prima facie* case of obviousness against any of claims 1-3, 5, 7, 8, 10-27, 29, or 31.

Despite the U.S. Supreme Court's insistence in *KSR Int'l Co. v. Teleflex Inc.*, 55 U.S. ___, 127 S. Ct. 1727 (2007) that there must be some motivation, such as a market force, for one of ordinary skill in the art to have combined and/or modified prior art teachings in such a way as to render a claim obvious, the Examiner asserts that, in this case, "there is no requirement that one skilled in the art would need to be aware of 'any demand for scented bowling balls.'" Examiner's Answer, page 10. It appears that the Examiner believes that the law, as clarified by the Supreme Court, does not apply in cases where the change to a prior art apparatus (in this case, the addition of fragrance to an article of manufacture such as a bowling ball) is "nothing more than a novelty..." *Id.* Nonetheless, the Supreme Court's opinion in *KSR* did not eliminate the requirement that the Office demonstrate that one of ordinary skill in the art would have been motivated to modify or combine reference teachings when asserting that the claims of a patent application are obvious.

In this case, the Examiner has not pointed to any motivation for one of ordinary skill in the art, in Shinbanai, Coffey, or elsewhere, to incorporate fragrance into bowling balls, as would have been required to render obvious the subject matter recited in claims 1-3, 5, 7, 8, and 10-19.

Furthermore, without the benefit of hindsight, one of ordinary skill in the art wouldn't have been motivated to combine teachings from Shinbanai and Coffey in the asserted manner. Shinbanai teaches processes for incorporating relatively small amounts of natural or synthetic fragrance into a relatively large amount of polymer, whereas the teachings of Coffey relate to articles of manufacture that are composed primarily of fragrant botanical matter, with only a small amount of resin being used to bind particles of the botanical matter to each other.

Moreover, even assuming that one of ordinary skill in the art would have contemplated combining teachings from Shinbanai and Coffey in the asserted manner, doing so would not result in the articles of manufacture to which claims 1-3, 5, 7, 8, 27, 29, and 31 are drawn or in the methods of any of claims 10-26. Specifically, neither Shinbanai nor Coffey teaches or suggests a fragrance that is "at least partially dissolved [in] at least a portion of [a] two-part resin" (independent claims 1 and 27) or a method that includes "blending at least one fragrance directly into" a liquid material, such as a polyol (independent claims 10 and 20). The teachings of Shinbanai are instead directed to incorporating fragrance into a cyclodextrin, which is then coated with a glycol, whereas the teachings of Coffey relate to fragrance within plant matter, with particles of the plant matter merely being bound to one another with a small amount of resin.

Even if some motivation to combine reference teachings had been established, it is respectfully submitted that the secondary considerations of nonobviousness—specifically

commercial success—favor allowance of the claims that are pending in the above-referenced application. With respect to commercial success, the facts speak for themselves – an increasingly large number of bowling balls that are within the scope of claims of the present invention or that have been manufactured in accordance with claimed methods, have been sold since their market introduction. The Examiner asserts that the increased sales numbers could be due to increased advertising, discounts, or any number of other factors. This assertion, however, ignores the fact that, in such a lucrative industry, Storm Products’ competitors would also market, provide discounts, and devise other ways to increase sales of their own bowling balls and maintain or improve their market share. Nonetheless, Storm Products’ share of the relevant market has continuously increased since its scented bowling balls were introduced into the marketplace.

Additionally, the evidence that has been submitted in the ‘141 Application shows the immense publicity, for which Storm Products has not paid, that has been generated by bowling balls that are themselves within the scope of claims of the ‘141 Application, and that have been manufactured by processes recited in the claims of the ‘141 Application. Such publicity reveals that scented bowling balls met a previously unrecognized and unmet need in the bowling industry.

(9) EVIDENCE APPENDIX

An unsigned third Declaration of John W. Chrisman, III, was previously submitted in the ‘141 Application and was again submitted with the Appeal Brief in the ‘141 Application. That declaration has since been executed by Mr. Chrisman, and is attached as supplemental EVIDENCE APPENDIX to this Reply Brief.

(11) CONCLUSION

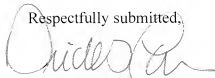
It is respectfully submitted that:

(A) Each of claims 1-3, 5, 7, 8, 10-27, 29, and 31 is drawn to subject matter that, under 35 U.S.C. § 103(a), is patentable over the teachings of Shinbanai and Coffey; and

(B) Claims 9, 32, and 33 are allowable under 35 U.S.C. § 103(a) for being drawn to subject matter that is patentable over the subject matter taught in Shinbanai, in view of teachings from Coffey and, further, in view of the teachings of Anderson.

Accordingly, it is respectfully requested that the 35 U.S.C. § 103(a) rejections of claims 1-3, 5, 7-9, 10-27, 29, and 31-33 be reversed, and that each of these claims be allowed.

Respectfully submitted,



Brick G. Power
Registration No. 38,581
Attorney for Applicants
TRASKBRITT, PC
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: November 13, 2007
BGP/ec
Document in ProLaw